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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding | 92058143 |
| Party | Plaintiff<br>Van de Wall B.V. |
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| Submission | Reply in Support of Motion |
| Filer's Name | Babatunde Williams |
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| Signature | /Babatunde Williams/ |
| Date | 06/24/2015 |
| Attachments | CancelNo92058143-PsReplyToRsResponse-Signed.pdf(748167 bytes ) |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

VAN DE WALL B.V.

Petitioner,

v.

Cancellation No. 92058143

D-MINOR, INC.

Respondent.

PETITIONER'S REPLY TO RESPONDENT'S RESPONSE TO PETITIONER'S MOTION TO COMPEL DISCOVERY

Pursuant to TBMP § 523 and 37 C.F.R. § 2.120(e), VAN DE WALL B.V. ("Petitioner") respectfully maintains its motion seeking an order for the Board to compel D-MINOR, INC. ("Respondent") to respond to written discovery requests, and produce responsive, non-privileged documents and a privilege log. In support of this motion, Petitioner states as follows:

BACKGROUND

On May 26, 2015, after Petitioner's good faith effort to resolve the dispute directly with Respondent via telephone and multiple emails proved unsuccessful, Petitioner filed the instant motion to compel discovery (the "Motion"), including documentary evidence of Petitioner's good faith effort. On June 15, 2015, Respondent filed a response in opposition to the Motion.

ARGUMENT

**Respondent's Recitation Of Facts Consists Of Nothing More Than Self-Serving Statements Without Any Supporting Evidence And Therefore Should Be Accorded Little, If Any, Weight**

Because Respondent fails to substantiate its allegations about the facts and circumstances leading up to Petitioner's filing of the Motion with any supporting evidence, these allegations should be accorded little, if any, weight. Respondent should not be permitted to prevail in its opposition to the Motion by relying solely on a series of unsubstantiated assertions about the parties' conduct in this matter.

1. Respondent alleges that it served responses to Petitioner's first set of discovery requests, in the same envelope as Respondent's first set of discovery requests, via first class mail on March 30, 2015.

Respondent also alleges that it sent discovery responses via courtesy email on April 3, 2015.[1] However, Petitioner still has not received any copies of Respondent's discovery responses or any paper copies of Respondent's discovery requests.[2] Respondent has not even produced copies of its discovery responses for the Board's review, or a copy of any certificate of service for its discovery responses, or a copy of any email showing that courtesy copies of its discovery responses were also emailed to Petitioner as directed in the Board Order dated August 15, 2014.

2. Respondent complains that Petitioner did not call Respondent during the month of April 2015 to notify Respondent that its discovery responses were not received. Respondent's complaint rings hollow because Respondent's discovery responses were not due until May 5, 2015, and therefore Petitioner had no reason to notify Respondent, via telephone or otherwise, during the month of April 2015. On May 11, 2015, after allowing a few business days to pass for paper copies to arrive, and just six days after Respondent's discovery responses were due, counsel for Petitioner called counsel for Respondent to inform him that the responses had not yet been received, and to discuss how the parties could resolve the issue without the Board's involvement. Petitioner's May 11, 2015 email serves as a contemporaneous record of Petitioner's May 11, 2015 telephone communication with Respondent, the accuracy of which went unchallenged by Respondent until its response to the Motion.

3. Respondent alleges that it has "repeatedly communicated to Petitioner that the flow of this proceeding can be greatly aided by prompt good faith communication via telephone." This claim does not withstand scrutiny, in that Petitioner has in fact made a good faith effort to resolve the dispute through communication with Respondent via telephone and email, and has provided evidence of its good faith effort. *See* Exhibit A and Exhibit B to the Motion. By contrast, Respondent's failure to provide any discovery responses whatsoever, or follow up on Petitioner's May 11, 2015 telephone call, or reply to Petitioner's May 11, 2015 email or Petitioner's May 18, 2015 email, or initiate any of its own communication with Petitioner in connection with the dispute, strongly suggests that Respondent has not made a good faith effort to resolve the dispute.

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[1] Insofar as these proceedings were not instituted until November 5, 2013, Petitioner assumes that Respondent's reference to April 3, 2013 was an inadvertent error, and that Respondent intended to specify April 3, 2015.

[2] Petitioner has acknowledged receipt of the copies of Respondent's discovery requests that were received via courtesy email on April 3, 2015, after the close of discovery on April 1, 2015.

4. Respondent alleges that the Board has admonished Petitioner for its "lack of timely telephonic communication," without attaching or citing to any communication from the Board to substantiate its claim. Petitioner is not aware of any instance in this proceeding when the Board has admonished Petitioner for any reason.

5. Counsel for Respondent alleges that, upon being informed on Monday, May 11, 2015 that Petitioner had not received Respondent's discovery responses, he "indicated he would forward copies of the Registrant's responses when he returned to his Atlanta office the following Monday." In fact, counsel for Respondent stated only that he would "re-email" the responses later in the week and was evasive when pressed for a more definite date. In the spirit of cooperation, Petitioner informed counsel for Respondent that he could resend the responses by the close of business on Friday, May 15, 2015 and then waited until an additional ten days had passed before filing the Motion. Counsel for Petitioner also stated that because the responses were late, Respondent should provide its responses without objection on the merits. As noted above, Petitioner's May 11, 2015 email serves as a contemporaneous record of Petitioner's May 11, 2015 telephone call.

**The Board Should Sustain Petitioner's Motion To Compel Discovery Without Objection On The Merits Because Respondent Has Not Shown That Its Failure To Timely Serve Discovery Responses Could Constitute Excusable Neglect**

In its response to the Motion, Respondent argues that Petitioner will not be prejudiced by the Board's refusal to require Respondent to serve discovery responses without objection on the merits. However, the danger of prejudice to Petitioner is just one of several factors to be considered by the Board when determining whether the facts and circumstances surrounding Respondent's continuing failure to serve discovery responses constitute excusable neglect. These factors include (1) the danger of prejudice to the nonmovant, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith. *See Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership*, 507 U.S. 380, 395 (1993); *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 (TTAB 1997). It has been held that the third *Pioneer* factor may be deemed to be the most important of the factors in a particular case. *See Luster Products Inc. v. Van Zandt*, 104 USPQ2d 1877, 1879 (TTAB 2012); *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1307-08 (TTAB 2007); *Baron*

*Philippe de Rothschild S.A. v. Styl-Rite Optical Manufacturing Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000); *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1158 (TTAB 1998).

Starting with the third *Pioneer* factor, Respondent's failure to serve responses to Petitioner's discovery requests when due was caused by circumstances wholly within Respondent's control. Similarly, the continuing failure to provide any discovery responses whatsoever is an intentional choice wholly within the control of Respondent. Since first being notified that its discovery responses have not been received by Petitioner, Respondent has neither provided a copy of the responses it alleges were timely served, nor provided responses without objection on the merits as requested by Petitioner, nor made any other effort to resolve the issue directly with Petitioner.

With respect to the second *Pioneer* factor, Respondent's uncooperative conduct has resulted in considerable delay in these proceedings, taking into account the time between the expiration of the time for taking action and the filing of the Motion, as well as the unavoidable delay arising from the time required for briefing and deciding the Motion. It should also be noted that Respondent's conduct has resulted in an additional strain on the Board's resources. Respondent's withholding of the discovery responses which it alleges were timely served, but which Respondent has yet to provide despite a proclaimed willingness to do so, forced Petitioner to file the Motion.

As for the fourth *Pioneer* factor, the unsubstantiated assertions made by Respondent in its response to the Motion, which directly conflict with the evidence of Petitioner's good faith effort to resolve the dispute, strongly suggest that Respondent has not acted in good faith in this matter. Respondent has yet to provide Petitioner or the Board with copies of the discovery responses it alleges were timely served, or a copy of any certificate of service for said discovery responses, or a copy of any email showing that courtesy copies of said discovery responses were also emailed to Petitioner as directed in the Board Order dated August 15, 2014. In addition, Respondent did not follow up on or reply to any of Petitioner's communications, or initiate any of its own communication with Petitioner, in a good faith effort to resolve the dispute.

Based on the above analysis, Petitioner respectfully submits that Respondent has failed to show that its failure to timely serve responses could constitute excusable neglect and therefore Respondent should be compelled to respond to Petitioner's discovery requests without objection on the merits.

## CONCLUSION

Petitioner respectfully requests that the Board issue an order compelling Respondent to respond to Petitioner's discovery requests in accordance with the requirements of 37 C.F.R. § 2.120(a)(3), without objection on the merits, and serve such responses in accordance with the requirements of 37 C.F.R. § 2.119.

Dated: June 24, 2015

By: _____
Kurosh Nasseri

By: _____
Babatunde Williams

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Attorneys for Petitioner

## CERTIFICATE OF SERVICE

I do hereby certify that on this 24th day of June, 2015, a copy of the foregoing PETITIONER'S REPLY TO RESPONDENT'S RESPONSE TO PETITIONER'S MOTION TO COMPEL DISCOVERY has been sent to counsel for Respondent by first class mail, postage prepaid, in an envelope addressed to:

Leslie A. Thompson, Esq.
Leslie A. Thompson & Associates
1629 K Street NW, Suite 300
Washington, DC 20006

I do hereby further certify that on this 24th day of June 2015, a courtesy copy of the foregoing PETITIONER'S REPLY TO RESPONDENT'S RESPONSE TO PETITIONER'S MOTION TO COMPEL DISCOVERY has been sent to counsel for Respondent by email to the following email address:

lat@thompsoniplaw.com

Michelle Katz

Michelle Katz

6/24/15

Date